Patent
Attorney's Docket No. 032367-449

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
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Burton G. CHRISTENSEN, et al.	)	
	)	
Application No.: 09/457,926	)	Group Art Unit: 1627
	)	
Filed: December 8, 1999	)	Examiner: M. Garcia
	)	
For: NOVEL ANTI-BACTERIAL AGENTS	)	
	)	

REPLY TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This reply is in response to the Office Action (Paper No. 9) mailed on February 20, 2001, in the above-identified patent application. The Office Action, which constituted a restriction requirement and an election of species requirement, set a one (1) month period for response and this Reply is being submitted on or before its current due date of March 20, 2001. In response to this Office Action, consideration of the following remarks is requested.

REMARKS

Applicant respectfully requests that this application be reconsidered in view of the following remarks. Claims 41-56 are now pending in this application.

Requirement for Restriction

In the Office Action mailed February 20, 2001, the Examiner has indicated that restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I: Claims 41-55, drawn to "multibinding" compounds and pharmaceutical compositions comprising the compounds; and

Group II: Claim 56, drawn to a method for treating diseases.

In response to this restriction requirement, Applicants elect, with traverse, Group I.

Initially, Applicants note that while Group I in the restriction requirement refers to "multibinding compounds", none of Claims 41-55 employ this term. Accordingly, it is submitted that the term "multibinding" as it is found in the Office Action is in error.

In any event, this election is traversed to the extent that Applicants submit that Groups I and II should be combined for the following reasons. In MPEP §803, it states that:

"An application may properly be restricted to one of two or more claimed inventions if (a) the inventions are independent or distinct as claimed; and (b) a serious burden is imposed on the Examiner if restriction is not required. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. Moreover, the Examiner must provide reasons and/or examples to support conclusions regarding a need for restriction, but need not cite documents to support the requirement in most cases. *See* MPEP § 803 "GUIDELINES".

In the present case, Applicants submit that restriction between the subject matter directed to compounds and pharmaceutical compositions comprising these compounds (Group I) and methods for treating bacterial diseases using these pharmaceutical compositions (Group II) is not proper or necessary and that this restriction requirement be withdrawn.

Specifically, Group I covers compounds and pharmaceutical compositions comprising these compounds wherein the compounds are specifically defined by reference to specific structures and substituents. Group II covers methods for treating bacterial diseases by using the pharmaceutical compositions of Group I.

Applicants submit that a combined search and examination of the Groups I and II should not impose an undue burden on the Examiner since any pertinent art relating to the compounds and pharmaceutical compositions of Group I is also likely to be relevant to the methods for treating bacterial diseases of Group II. In fact, one would expect to find reference to pharmaceutical compositions containing compounds and pharmaceutical compositions of Group I and methods for treating bacterial diseases of Group II in the same documents.

Accordingly, Applicants submit that an undue burden would not be imposed on the Examiner if these groups were examined together and respectfully request that this requirement to restrict the inventions defined by Groups I and II into separate groups be withdrawn.

Election of Species:

The Office Action further states that if Group I is elected, Applicants are further required to elect from the following patentably distinct species:

Species of β-lactam Antibiotic (L')

Species 1:	Moiety of formula (a)	Claim 42
Species 2:	Moiety of formula (b)	Claims 43, 53 and 54
Species 3:	Moiety of formula (c)	Claim 44
Species 4:	Moiety of formula (d)	Claim 45
Species 5:	Moiety of formula (e)	Claim 46

Species of glycopeptide Antibiotic (L")

Applicant is required to elect a single glycopeptide antibiotic from those set forth in claims 47 and 48 with the proviso that, if vancomycin is selected, then a further election should be made between the various linkage sites of Claims 49-51. In response to this requirement, Applicants elect the following species:

Species of β-lactam Antibiotic (L')

Species 2: Moiety of formula (b) Claims 43, 53 and 54

Species of glycopeptide Antibiotic (L")

Vancomycin

As required by the election of species requirement, Applicants elect the linkage site set forth in Claim 49, i.e., through the vancosamine nitrogen atom of vancomycin.

Claims 41, 43, 47- 49 and 52-55 are believed to read on the elected species.

Consistent with MPEP §809.02(a), if generic Claim 41 is allowed, then Applicants are entitled to consideration of the non-elected dependent species claims, including Claims 42, 44-46 and 50-51. The undersigned requests to be notified if the above is inconsistent with any construction of the considered claims by the USPTO.

Early examination on the merits is requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____

Gerald F. Swiss
Registration No. 30,113
Attorney for Applicants
Redwood Shores, CA Office
(650) 622-2300

P.O. Box 1404
Alexandria, Virginia 22313-1404

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